UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,528	02/02/2001	Yoshinori Takahashi	121.1016	6279

21171	7590	01/04/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
REAGAN, JAMES A

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/773,528	TAKAHASHI ET AL.
	Examiner	Art Unit	
	James A. Reagan	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _25 October 2005_.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-26_ is/are pending in the application.

    4a) Of the above claim(s) _16-26_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-15_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the Restriction election filed on 25 October 2005.

2. Claims 1-15 have been elected.

3. Claim 1-12, 14, and 15 have been amended.

4. Claims 1-15 have been examined.

5. The rejections of claims 1-15 have been maintained pending the review of the Examiner's proposed amendments.

RESPONSE TO ARGUMENTS

6. Applicant's arguments received on 25 October 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

7.   As per the telephone interview with Randy Beckers conducted on 29 December 2005, the

Examiner is submitting this proposal to better place the claims in condition for allowance.

        a.   Combine claims 1 and 2;

        b.   Combine claims 3 and 4;

        c.   Combine claims 5 and 6;

        d.   Combine claims 10 and 11;

        e.   Combine claims 12 and 13;

        f.   Include the limitations of claim 2 in each of claims 7, 8, 9, 14, and 15;

        g.   Place the following claim limitations contained within claim 8 into each of claims

        1, 3, 5, 7, 8, 9, 10,12, 14, and 15:

        o   in a case that the sum of the software-license usage numbers of all sections

                of the organization exceeds the software-license holding number, in

                response to such a determination automatically generating a purchase

                transaction for purchasing software licenses based on a difference between

                the sum and the software-license holding number;

        o   adding a number of purchased software licenses to the software-license

                holding number; and

        o   distributing a purchase expense to a section whose software-license usage

                number is greater than the corresponding software-license right number. and

                updating the software-license right number of the section.

        Subsequent to the Applicant agreeing to and implementing this proposed amendment,

the Examiner will grant a speedy notice of allowability, pending a final cursory search of the

allowable subject matter. This action is **NON-FINAL,** pending a review of this suggestion.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country
or in public use or on sale in this country, more than one year prior to the date of application
for patent in the United States.

9.   Claims 1, 3, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bereiter, US

Patent No. 5,754,763.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art

of record within the body of this action for the convenience of the Applicant. Although the

specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply. Applicant, in

preparing the response, should consider fully the entire reference as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

Claims 1 and 10:

Bereiter discloses:

- *an [apparatus/medium) for managing software licenses (Abstract; Summary of the
Invention) comprising:*

- *[Means/unit] for managing a total number of software licenses owned by an entire
organization (Abstract; Summary of the Invention);*

- *for collecting inventory information from each of a plurality of computers within the organization, the inventory information including information regarding software actually installed in each computer (Abstract; Summary of the Invention); and*

- *for calculating a difference between the number of software licenses owned by the entire organization and a number of software licenses actually in use which is calculated on the basis of the collected inventory information (Abstract; Summary of the Invention) and for outputting information representing an excessive or insufficiency in the number of software licenses or information regarding purchase of additional software licenses (C9, L23-36).*

With regard to the limitation of where the inventory information is collected without regard for whether or not the installed software is currently executing, Bereiter, in at least column 1, line 12 to column 2, line 9, discloses the traditional technique of managing license information by maintaining a license server which polices a network for license violations without regard or mention of currently executed programs or applications, also disclosed by the Applicant in the background of the current specification.

Claims 3 and 12:

Bereiter discloses

- *an [apparatus/medium] for managing software licenses (Abstract; Summary of the Invention) comprising:*

- *means for storing a total number of software licenses owned by an entire organization and a total number of software licenses allotted to each section of the organization (Abstract; Summary of the Invention; Fig 1, associated text);*

- *means for collecting inventory information from each of a plurality of computers within the organization (Abstract; Summary of the Invention), the inventory information including information regarding software actually installed in each computer; and*

- *means for calculating a difference between the number of software licenses allotted to each section of the organization and a number of software licenses actually used in the section which is calculated on the basis of the collected inventory information (Abstract; Summary of the Invention) and for outputting warning information in a case that the number of software licenses in actual use is greater than the number of allotted software licenses (Fig 7: "Issue Warning"; associated text; C8, L62 - C9, L7).*

With regard to the limitation of where the inventory information is collected without regard for whether or not the installed software is currently executing, Bereiter, in at least column 1, line 12 to column 2, line 9, discloses the traditional technique of managing license information by maintaining a license server which polices a network for license violations without regard or mention of currently executed programs or applications, also disclosed by the Applicant in the background of the current specification.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 2, 4-9, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bereiter in view of Duvvoori et al., US Patent No. 6.021,438.

Claim 5:

Bereiter discloses all the limitations of this claim (see all above citations) except for outputting

information, which indicates that the section is allotted an excess number of software licenses

compared with the number of software licenses in actual use. Duvvoori, however, discloses that

reports will be generated based on the auditing of license usage (C7, L8-11: reports: Fig 1, associated

text). While neither reference specifically recites the exact language of the above limitation, it would

have been obvious to one ordinarily skilled in the art at the time the invention was made that inherent

with a surveying/auditing of license usage within a corporate organization, efforts will be made to

maximize the use of all purchased licenses, and management would want to know where such

allocated licenses were not being used, in order to maybe to change or redistribute that allocation.

Claims 2, 4, 6, 11, and 13:

Bereiter discloses all the limitations of claims 1, 3, 10 and 12. Bereiter in view of Duvvoori

disclose all the limitations of claim 5. Neither reference specifically recites:

- *generating a software dictionary which identifies software during collection of the inventory information;*

- *wherein the means for collecting the inventory information collects the inventory information by using the generated software dictionary which is distributed to each of the plurality of computers in the organization from which the inventory information is . collected.*

However, Duvvoori discloses using "replicated databases" (C2, L61 -C3, L10) identifying

pertinent information about the software licenses to be surveyed/audited to be duplicated on local

machines and which will be used to collect license usage data at each such local machine. It would

have been obvious to one ordinarily skilled in the art at the time the invention was made to combine

the teachings of Bereiter and Duvvoori, to allow for a "dictionary" or database identifying pertinent

information about the software licenses to be surveyed/audited to be duplicated on local machines, in

order to make the collection of usage data at each machine of a wide area network faster and more

responsive to network-wide collection requests from the central server.

Claims 7 and 14:

Bereiter discloses:

- *an [apparatus/medium] for managing software licenses (see all above citations) comprising: means for managing a number of software licenses owned by an entire organization;*

Duvvoori discloses:

- *means for generating, ... a software dictionary (C2, L61 - C3, L10: "replicated databases") for identification of software and a license policy used for determination of presence of a license;*

- *means for distributing the software dictionary, over a network, to each of a plurality of computers within the organization in order to collect inventory information from each of the computers, the inventory information including information regarding software actually installed in each computer (C2, L61 - C3, L10: "replicated databases"); and*

- *means for reporting ...a usage number of software licenses calculated on the basis of the collected inventory information and the license policy (C7, L8-11: reports: Fig 1, associated text).*

It would have been obvious to one ordinarily skilled in the art at the time the invention was

made to combine the teachings of Bereiter and Duvvoori, to allow for a "dictionary" or database

identifying pertinent information about the software licenses to be surveyed/audited to be duplicated

on local machines, in order to make the collection of usage data at each machine of a wide area network faster and more responsive to network-wide collection requests from the central server.

Neither reference specifically recites:

- *means for receiving from a higher-level server an organization-wide policy which is information regarding a logic for collection of a usage number of software licenses;*

However, Bereiter discloses a network (Fig 1, associated text) consisting of a higher authority server linked to node servers and managed nodes. Duvvoori also discloses a central server that manages organization-wide software license policy (Fig 1, associated text). Both systems are directed to software license management within a large, enterprise-wide organization, with central authority for determining license counts and policy. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that in both systems taught by the references, a "higher-level server" would inherently dictate policy and the logic for collection of software license usage and the generation of reports resulting from such surveying. This organization setup of course is necessary in order to provide uniform license policy and adherence to it by all user nodes within the organization.

Claims 8 and 15:

Both Bereiter and Duvvoori disclose the following limitations:

- *managing a software-license holding number which represents a number of software licenses owned by an entire organization, and managing, for each section of the organization, a software-license right number which represents a total number of software licenses permitted to be used and a software license usage number which represents a total number of software licenses in actual use;*

- *collecting, over a network, inventory information from each of a plurality of computers within the organization, the inventory information including information regarding*

software actually installed in each computer, and updating the software-license

usage number of each section of the organization;

Neither reference specifically discloses:

- *in a case that the sum of the software-license usage numbers of all sections of the organization exceeds the software-license holding number, generating a purchase transaction for purchasing software licenses equal in number to a difference between the sum and the software-license holding number;*

- *adding a number of purchased software licenses to the software-license holding number; and*

- *distributing a purchase expense to a section whose software-license usage number is greater than the corresponding software-license right number, and updating the software-license right number of the section.*

However, Bereiter does disclose that "remedial" actions would be taken should additional software licenses become necessary, including the issuing of purchase orders for more licenses (C9, L34-36). It would have been obvious to one skilled in the art at the time the invention was made that these further limitations of claim 8 would be inherent in any organization, when software is properly needed by its authorized employees, and when the current license count come up short. Issuing purchase orders for more license units and billing the department to which the additional licenses are assigned would be standard business practice.

Claim 9:

The same prior art and obviousness analysis apply to all the limitations of this claim. It would have been obvious to one ordinarily skilled in the art that once the number of required licenses exceeds the non-use number of licenses for that same product, a business organization would inherently make a decision to purchase the difference between those two numbers, as a standard business practice.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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JAMES A. REAGAN

Primary Examiner

Art Unit 3621

29 December 2005